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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/285,700	04/05/1999	YASUO NISHIDA	P17762	4029

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EXAMINER

POKRZYWA, JOSEPH R

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 03/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/285,700

Applicant(s)

NISHIDA ET AL.

Examiner

Joseph R. Pokrzywa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 January 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 7-11, 16, 29 and 53-66 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-11, 16, 29 and 53-66 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Response to Amendment*

1. Applicant's amendment was received on 1/16/03, and has been entered and made of record. Currently, **claims 7-11, 16, 29, and 53-66** are pending. With the amendment, the previous group of elected claims were all canceled, leaving the previously non-elected claims to be now examined, along with new claims 53-66, which are both drawn to the same invention.

### *Claim Objections*

2. **Claims 53, 59, 60, and 66** are objected to because of the following informalities:

In **claim 53**, line 4 (two occurrences), "electric mail" should read "electronic mail";

In **claim 59**, line 4 (two occurrences), "electric mail" should read "electronic mail";

In **claim 60**, line 4 (two occurrences), "electric mail" should read "electronic mail";

In **claim 66**, line 1 (one occurrence) and line 3 (two occurrences), "electric mail" should read "electronic mail".

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. **Claims 7-11, 16, 20, 53-57, 59-64, and 66** are rejected under 35 U.S.C. 102(e) as being anticipated by Suzuki (U.S. Patent Number 6,005,677).

Regarding **claim 7**, Suzuki discloses an image communication apparatus (facsimile devices FA1 and FA2, seen in Figs. 1 and 2) comprising a public switched telephone communication means (network controlling apparatus 10) for receiving and transmitting data on a public switched telephone network (column 3, lines 3 through 46), receiving means (LAN communication controlling unit 11) for receiving an image over the Internet (see Fig. 1, and column 2, line 61 through column 3, line 2, and column 3, lines 47 through 53), and receiver side information transmitting means (system control section 1, column 3, lines 11 through 22) for

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transmitting self-information to a transmitter side using the public switched telephone communication means (column 5, lines 4 through 13, and column 5, lines 53 through 59).

Regarding *claim 8*, Suzuki discloses the apparatus discussed above in claim 7, and further teaches that the receiver side information includes information of whether or not the receiver side has a capability of receiving and transmitting the image over the Internet (column 5, lines 4 through 13, and column 5, lines 53 through 59, and column 10, lines 3 through 17).

Regarding *claim 9*, Suzuki discloses the apparatus discussed above in claim 7, and further teaches that the public switched telephone communication means receives receiver side information during a communication control protocol (column 5, lines 4 through 59).

Regarding *claim 10*, Suzuki discloses the apparatus discussed above in claim 9, and further teaches that the public switched telephone communication means receives and transmits data on a facsimile communication protocol (column 3, lines 36 through 65, column 5, lines 4 through 59).

Regarding *claim 11*, Suzuki discloses the apparatus discussed above in claim 10, and further teaches that the receiving means receives the image on an electronic mail communication protocol (column 10, lines 27 through 59).

Regarding *claim 16*, Suzuki discloses an image communication apparatus (facsimile devices FA1 and FA2, seen in Figs. 1 and 2) comprising transmitting means (network controlling apparatus 10, and column 3, lines 3 through 46) for transmitting data including a self-capability to a transmitter side on a public switched telephone network (column 5, lines 4 through 13, and column 5, lines 53 through 59), receiving means (LAN communication controlling unit 11) for

receiving an image from the transmitter side over the Internet (see Fig. 1, and column 2, line 61 through column 3, line 2, and column 3, lines 47 through 53).

Regarding **claim 20**, Suzuki discloses an image communication apparatus (facsimile devices FA1 and FA2, seen in Figs. 1 and 2) comprising transmitting means (network controlling apparatus 10, and column 3, lines 3 through 46) for transmitting data including a self-capability to a transmitter side (column 5, lines 4 through 13, column 5, lines 53 through 59, and column 9, lines 36 through 56), and receiving means (LAN communication controlling unit 11) for receiving an image from the transmitter side over the Internet (see Fig. 1, and column 2, line 61 through column 3, line 2, and column 3, lines 47 through 53).

Regarding **claim 53**, Suzuki discloses a communication apparatus (facsimile devices FA1 and FA2, seen in Figs. 1 and 2) comprising a facsimile communicator (network controlling apparatus 10) that performs a facsimile communication with a facsimile destination via a telephone network (column 3, lines 3 through 46), an electronic mail communicator (LAN communication controlling unit 11) that performs electronic mail communication with a destination terminal via a computer network (see Fig. 1, and column 2, line 61 through column 3, line 2, and column 3, lines 47 through 53, and column 10, lines 27 through 59), and a detector (system controller 1) that detects identification information included in a non-standard signal which is transmitted from a facsimile destination while the facsimile communicator performs a facsimile protocol transmission to the facsimile destination (column 5, lines 4 through 13, and column 5, lines 53 through 59), the identification information indicating that a facsimile destination is capable of an electronic mail communication (column 10, lines 3 through 59).

Regarding **claim 54**, Suzuki discloses the apparatus discussed above in claim 53, and further teaches of a memory that is configured to store the identification, associated with the facsimile destination (telephone number conversion table, seen in Fig. 3, column 3, line 63 through column 4, line 6, and column 5, lines 4 through 13).

Regarding **claim 55**, Suzuki discloses the apparatus discussed above in claim 53, and further teaches of a facsimile communication controller that disconnects the facsimile communication when the detector detects the identification information in the non-standard signal (column 5, lines 4 through 28, seen in Fig. 4, specifically, step 120 restores the telephone line).

Regarding **claim 56**, Suzuki discloses the apparatus discussed above in claim 55, and further teaches that electronic mail communicator starts to perform the electronic mail communication with the facsimile destination upon disconnection of the facsimile communication (column 4, lines 14 through 45, and column 10, lines 3 through 59, wherein upon disconnection of the facsimile communication, the next time the apparatus transmits a document to the specified destination, a address received and stored in the previous facsimile communication would be obtained and used to “start to perform the electronic mail communication with the facsimile destination”).

Regarding **claim 57**, Suzuki discloses the apparatus discussed above in claim 53, and further teaches that the non-standard signal includes capability information of the facsimile destination (column 5, lines 53 through 59, and column 9, lines 36 through 45).

Regarding **claim 59**, Suzuki discloses a communication apparatus (facsimile devices FA1 and FA2, seen in Figs. 1 and 2) comprising a facsimile communicator (network controlling

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apparatus 10) that performs a facsimile communication with a facsimile destination via a telephone network (column 3, lines 3 through 46), an electronic mail communicator (LAN communication controlling unit 11) that performs electronic mail communication with a destination terminal via a computer network (see Fig. 1, and column 2, line 61 through column 3, line 2, and column 3, lines 47 through 53, and column 10, lines 27 through 59), and an obtainer that obtains an electronic mail address of a facsimile destination (column 10, lines 27 through 59), included in a non-standard signal which is transmitted from the facsimile destination while the facsimile communicator performs a facsimile protocol transmission to the facsimile destination (column 5, lines 4 through 59), when the facsimile destination with which the facsimile communication section performs the facsimile communication (column 5, lines 4 through 59), is capable of the electronic mail communication (column 10, lines 3 through 59).

Regarding *claim 60*, Suzuki discloses a communication apparatus (facsimile devices FA1 and FA2, seen in Figs. 1 and 2) comprising a facsimile communicator (network controlling apparatus 10) that performs a facsimile communication with a facsimile sender via a telephone network (column 3, lines 3 through 46), an electronic mail communicator (LAN communication controlling unit 11) that performs electronic mail communication with a communication terminal via a computer network (see Fig. 1, and column 2, line 61 through column 3, line 2, and column 3, lines 47 through 53, and column 10, lines 27 through 59), and an adder (system control section 1, column 3, lines 11 through 42) that adds identification information to a non-standard signal which the facsimile communicator transmits to the facsimile sender during a facsimile protocol communication (column 5, lines 4 through 59), the identification information indicating that a



communication apparatus is capable of an electronic mail communication (column 5, lines 4 through 59, and column 10, lines 3 through 59).

Regarding **claim 61**, Suzuki discloses a method for identifying a destination terminal (facsimile devices FA1 and FA2, seen in Figs. 1 and 2), with the method comprising performing a facsimile communication with a destination terminal via a telephone network (column 3, lines 3 through 46), detecting whether identification information is included in a non-standard signal which is transmitted from the destination terminal while a facsimile protocol transmission is performed with the destination terminal (column 5, lines 4 through 13, and column 5, lines 53 through 59), the identification information indicating that the destination terminal is capable of an electronic mail communication (column 10, lines 3 through 59), and storing the identification information when the identification information is detected (column 5, lines 4 through 13).

Regarding **claim 62**, Suzuki discloses the method discussed above in claim 61, and further teaches of disconnecting the facsimile communication when the detecting detects the identification information in the non-standard signal (column 5, lines 4 through 28, seen in Fig. 4, specifically, step 120 restores the telephone line).

Regarding **claim 63**, Suzuki discloses the method discussed above in claim 62, and further teaches of initiating an electronic mail communication with the facsimile destination after the facsimile communication is disconnected (column 4, lines 14 through 45, and column 10, lines 3 through 59, wherein upon disconnection of the facsimile communication, the next time the apparatus transmits a document to the specified destination, a address received and stored in the previous facsimile communication would be obtained and used to “initiate an electronic mail communication with the facsimile destination”).

Regarding *claim 64*, Suzuki discloses the method discussed above in claim 61, and further teaches that the non-standard signal includes capability information of the facsimile destination (column 5, lines 53 through 59, and column 9, lines 36 through 45).

Regarding *claim 66*, Suzuki discloses a method for transmitting an electronic mail communication function capability from a receiving terminal to a facsimile sender (facsimile devices FA1 and FA2, seen in Figs. 1 and 2), the receiving terminal having an electronic mail communication section (LAN communication controlling unit 11) that performs electronic mail communication with a communication terminal via a computer network (see Fig. 1, and column 2, line 61 through column 3, line 2, and column 3, lines 47 through 53, and column 10, lines 27 through 59), with the method comprising performing a facsimile communication with a facsimile sender via a telephone network (column 3, lines 3 through 46), and adding identification information to a non-standard signal included in a facsimile protocol transmission while the facsimile communication is performed with the facsimile sender (column 5, lines 4 through 59, and column 9, lines 36 through 56), the identification information indicating that the communication apparatus is capable of an electronic mail communication (column 5, lines 4 through 59, and column 10, lines 3 through 59).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 58 and 65** are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki (U.S. Patent Number 6,005,677) in view of Fite, Jr. *et al.* (U.S. Patent Number 5,517,324).

Regarding **claims 58 and 65**, Suzuki discloses the apparatus and method discussed above in claims 57 and 64, respectively, but fails to particularly teach if the capability information includes at least resolution, print paper size, and coding system. Fite discloses a communication apparatus (fax machine 12, see Fig. 1, column 4, lines 50 through 66) comprising a facsimile communicator that performs a facsimile communication with a facsimile destination via a telephone network (column 4, lines 42 through 49), an electronic mail communicator that performs electronic mail communication with a destination terminal (column 4, lines 57 through 66), and a detector that detects identification information included in a non-standard signal which is transmitted from a facsimile destination while the facsimile communicator performs a facsimile protocol transmission to the facsimile destination (column 11, lines 56 through 67). Further, Fite teaches that the non-standard signal includes capability information of the facsimile destination (column 11, lines 56 through 67, and column 7, line 21 through column 8, line 34), and that the capability information includes at least resolution (column 3, lines 2 through 12, column 5, lines 3 through 24, and column 7, lines 1 through 20), print paper size (column 3, lines 2 through 12, column 5, lines 3 through 24, and column 7, lines 1 through 20), and coding

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system (column 5, line 3 through column 6, line 11, and column 7, lines 1 through 20).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Fite's teachings in the system of Suzuki. Suzuki's system would easily be modified to include the teachings of Fite, since the systems share cumulative features being additive in nature.

### *Citation of Pertinent Prior Art*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

**Malik** (U.S. Patent Number 6,104,505) discloses a system which routes a facsimile message to an appropriate destination terminal based on information found in a non-standard frame; and

**Lim** (U.S Patent Number 5,125,025) discloses a facsimile system that communicates capability information through the non-standard facilities command.

### *Conclusion*

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

J.R.P.

Joseph R. Pokrzywa  
Examiner  
Art Unit 2622

jrp  
March 14, 2003

  
**MADELEINE NGUYEN**  
**PATENT EXAMINER**

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